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EXAMINER

FADOK, MARK A

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/003,150
Filing Date: November 02, 2001
Appellant(s): SIMPSON ET AL.

David R. Risley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/26/2006 appealing from the Office action mailed 2/9/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,924,878

Garfinkle et al.

08-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,7,11,13 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Garfinkle (US 6,924,878).

In regards to claim 1, Garfinkle discloses a method for facilitating pay printing (abstract), the method comprising:

a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network (col 6, lines 1-25) ;
the printing service receiving print option selections (col 6, lines 1-25); and
the printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version (col 9, lines 53-65).

In regards to claim 2, Garfinkle teaches wherein the at least one store comprises a graphic store and a composition store (FIG 1).

In regards to claim 3, Garfinkle teaches wherein the at least one store is associated with an imaging source with which the full-sized document is created or identified (col 9, lines 22-50)).

In regards to claim 4, Garfinkle teaches wherein the imaging source comprises a network-based imaging service (FIG 1).

In regards to claim 7, Garfinkle teaches wherein the scaled down version comprises one or more thumbnails that represent document pages (see response to claim 6).

In regards to claim 11, Garfinkle teaches wherein receiving print option selections comprises receiving user selections with a web site of the network-based printing service (FIG 5D).

In regards to claim 13, Garfinkle teaches wherein the determination of the printing costs is dependent upon attributes of the scaled-down version and the option selections (FIG 5D).

In regards to claim 30, Garfinkle teaches wherein the scaled-down version is created by a network-based imaging service with which the full-sized document was created or identified (FIG 3B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of Official Notice.

In regards to claim 12, teaches a pay-for-print service that is supported by servers, but does not specifically mention that the service is supported by a printing device having an embedded server. It was old and well known in the art at the time of the invention to provide printing devices with embedded servers. It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide printing devices with embedded servers, because these devices would be acting as a vending machine for distributing the product and could therefore do some of the processing locally rather than having to be in communication with a remote server thus removing potential bandwidth issues.

(10) Response to Argument

Examiner understood definitions

The features relating to the “printing service” and “determining printing costs based upon attributes of the scaled-down version” were added in the 10/18/2005 amendment. To further understand the following arguments, the examiner defines these features as are understood by the specification as follows:

“Printing service” – The applicant points to item 318 in Fig 3 to show where the printing service is located, please note that this refers to the “print service web content” and not to the more general term “print service”. Item 318 is a web content server that provides web content (down-loads that are used to aid in the pay for print service), but does not apparently have within the context of item 318 the determining function that is the essence of the claim. Based on applicant’s disclosure the examiner takes this term “print service web content” to mean the entire pay-for-print process as is defined in FIG 8A and page 26, lines 11-21.

“Determining printing costs based upon attributes of the scaled-down version” - The examiner cannot find an exact correlation to this feature in applicant’s specification. Even though Appellant has cited certain sections of their specification that refers to costs being determined “based on the nature of the document”, the examiner does not understand this to mean that the system is reviewing any attributes of the scaled down version (thumbnail) to arrive at a cost. The examiner understands the

process to be downloading the thumbnail to a user so that the user can view the document/thumbnail to see if the image is desirable or printable.

Appellant argues that Garfinkle does not teach a network based printing service and that in Garfinkle the photographer, not any “network based printing service”, can retrieve an online proof sheet that contains small replicas of his images. The examiner disagrees and notes that Appellant argues that only the photographer receives the thumbnails inferring that the photographer is not part of the system. The examiner disagrees on two levels (1) in Garfinkle, the photographer refers to any party having authorization to view the images (col 3 – col 4, lines 1-10), such as when an operator accessing these images (col 9, lines 5-21) and (2) the examiner understands the appellant’s invention in relation to a printing service to be more than that described in item 318 of Figure 3 as stated by appellant and considers the “network based printing service” to encompass all of figures 1-9.

Appellant argues that Garfinkle does not teach, “determining printing costs for printing the full-sized document based upon attributes of the scaled down version”. Based on the above definitions, Garfinkle clearly teaches thumbnail prints being downloaded to a user to decide which prints are desired and also to see if there are alternative products that are desired by the user (col 6, lines 1-25, col 8, lines 33-40).

The pay for print system of Garfinkle uses price sheets to calculate the costs associated with desired products selected by the user to arrive at a price for the order (col 9).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Fadok
Primary Examiner

August 16, 2006

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